



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,241	09/09/2004	Kurt Stark	WAS0642PUSA	9080

22045 7590 03/20/2007
BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
----------	--------------

1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/507,241	STARK ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 to 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24 to 26, 29, 31 to 34, 38 to 47 is/are rejected.
- 7) ☒ Claim(s) 27, 28, 30, 35 to 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1712

1. In view of applicants' amendment requiring that the instant product be both solid and transparent, the Examiner has withdrawn the previous rejections. Upon an updated review of the art, considering these new limitations, the following new grounds of rejection are made.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24, 25, 29, 31 to 34 and 38 to 46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 00/70388, as interpreted by the English language equivalent Ito et al.

As noted in the previous office action and discussed by applicants in their reply, the claims are in product by process format. Applicants are of the position that this process results in an improved product that is transparent. In Ito et al., the process by which the silicone copolymer is different but it appears that the final products are the same. The copolymers in Ito et al. are produced by reacting the same monomers as claimed and, since the product is used as a lens, it will be transparent.

As can be seen from the abstract, Ito et al. teaches the reaction product of a siloxane having at least two unsaturated groups and a vinyl ester. See the preferred siloxane on the bottom of column 5 which meets claimed component b). The vinyl esters on column 6, lines 20 to 25, meet a). Column 8, line 49, teaches that when only the siloxane and vinyl ester are reacted, the weight ratio should be at least 30/70 (silox-

Art Unit: 1712

ane to vinyl ester). The preferred amount of at least 50/50 anticipates a composition having 50 wt% siloxane and 50 wt% vinyl ester. Again, since this composition is used as a lens, it will be both transparent and solid. Thus the claimed product appears to be the same as that disclosed by Ito et al.

For claim 29, on one hand this silane is not required to be present in the claimed composition. On the other hand, see component (C) on column 6, line 50 and on.

For claims 38 to 46, note that all that is required by these claims is the product itself.

5. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/70388, as interpreted by Ito et al.

The range of at least 30/70 siloxane/vinyl acetate overlaps with the claimed range of 5 to 40 wt% siloxane. One having ordinary skill in the art would have found the selection of a value of, for instance, 30 wt% siloxane to have been obvious since this is specifically taught as an operable lower limit.

6. Claims 24, 25, 29, 31 to 34 and 38 to 46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mueller et al.

Mueller et al. teach polysiloxane hydrogels. These are used to form lenses so they will be both solid and transparent. Please see Example 11. This reacts 45 grams of a methacrylate terminated siloxane with 15 grams of N-vinyl pyrrolidone and 60 grams of vinyl acetate. This meets the monomers and amounts of a1), a2) and b) in claim 24. Again, though this product is prepared by a different process than that by which the claimed product is prepared, the final products per se appear to be the same since they are formed from the same monomers in the same amounts and are solid and transparent.

For claim 29, note that this compound is not required in the composition of claim 24.

Art Unit: 1712

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al.

The example relied upon by the Examiner does not use a silicone meeting those in this claim but attention is directed to the general formula (B) on column 7; particularly to column 7, line 65, through column 8. This teaches that (meth)acrylate terminated siloxanes can be used in the alternative to those used in Example 11. It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. As such one having ordinary skill in the art would have found a siloxane within the breadth of claim 26 to have been obvious.

8. Claims 27, 28, 30 and 35 to 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

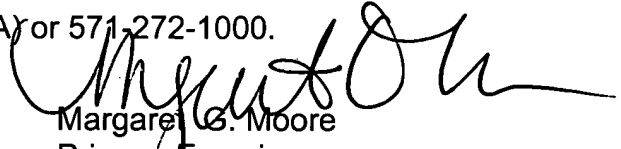
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

Art Unit: 1712

272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
3/16/07